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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08048.0026-00000

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Signature _____

Typed or printed name _____

Application Number

10/084,975

Filed

March 1, 2002

First Named Inventor

Jean-Louis H. Gueret

Art Unit

3732

Examiner

Robyn Doan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☐

attorney or agent of record

Registration number _____

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 56.065

Signature

Jeremy T. Thissell

Typed or printed name

571.203.2717

Telephone number

March 28, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 form is submitted.

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Customer No. 22,852
Attorney Docket No. 08048.0026

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Jean-Louis H. GUERET)	Group Art Unit: 3732
)	
Application No.: 10/084,975)	Examiner: Robyn Doan
)	
Filed: March 1, 2002)	Confirmation No.: 2195
)	
For: BRUSH FOR APPLYING)	Mail Stop: AF
PRODUCT TO KERATINOUS)	
FIBERS)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant respectfully requests pre-appeal brief, panel review of the claim rejections in the final Office Action dated December 28, 2005, for the following reasons.

I. Status of the Claims

Claims 1-111 are currently pending in this application, with claims 1, 43, 64, 80, and 96 being independent. Claims 13, 17-19, 28-32, 52-54, 56-60, 63, 73, 74, 89, 90, 105, and 106 have been withdrawn from consideration. In the Office Action, claims 1-12, 14-16, 20-27, 33-51, 55, 61, 62, 64-72, 75-88, 91-104, and 107-111 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,937,870 to Gueret ("Gueret") in view of U.S. Patent No. 5,176,156 to Ashtary et al. ("Ashtary").

II. The rejection of claims 1-12, 14-16, 20-27, 33-51, 55, 61, 62, 64-72, 75-88, 91-104, and 107-111 under 35 U.S.C. § 103(a) should be withdrawn

The rejection under 35 U.S.C. § 103(a) should be withdrawn because a case of *prima facie* obviousness has not been established with respect to independent claims 1, 43, 64, 80, and 96. A case of *prima facie* obviousness has not been established at least because (1) neither Gueret nor Ashtary, nor any combination thereof, teaches or suggests all of the features recited in the independent claims; and (2) the Office Action does not set forth a proper motivation to modify or combine Gueret and Ashtary.

The Office Action acknowledges that “Gueret does not disclose the free end of the brush portion not being aligned with the longitudinal axis of the one end portion of the stem.” Office Action, page 3, lines 15-17. The Office Action alleges that such a feature is shown in Fig. 2 of Ashtary. Office Action, page 3, line 21--page 4, line 3. The Office Action further alleges that “it would have been obvious . . . to employ the particular brush portion as taught by Ashtary et al into the mascara brush of Gueret for the purpose of enhancing the ability of the device to curl the eyelashes.” Office Action, page 4, lines 6-11.

Ashtary is directed to a mascara applicator device including a scissor mechanism for clamping two brushlike elements together. Abstract and Fig. 1. Contrary to the allegation in the Office Action, Fig. 2 of Ashtary does not necessarily disclose or suggest a device including, or a method involving, among other things, a “brush portion . . . free end . . . not aligned with the longitudinal axis of [an] end portion of [a] stem,” as recited in claims 1, 43, 64, 80, and 96. The text of Ashtary does not appear to describe any such subject matter. For example, Ashtary lacks any description of the orientation of the free end of the brushlike element 32 relative to a longitudinal axis of sleeve-like member 28. Therefore, it appears that the Examiner relies solely on Ashtary’s Fig. 2 in the claim rejection.

Drawings and pictures can disclose claimed structure if they clearly show the structure which is claimed. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972); see also MPEP 2125 (Emphasis added). In this case, however, the drawings of Ashtary do NOT clearly show the above-mentioned features of claims 1, 43, 64, 80, and 96. The limited views shown in the drawings of Ashtary do not provide an accurate indication of the orientation of the free end of the brushlike elements 32 with respect to respective longitudinal axes of the sleevelike members 28. As such, it is unclear whether or not the free ends of the brushlike elements 32 shown in Figs. 1 and 2 are aligned with the respective longitudinal axes of sleevelike members 28. Therefore, these drawings do not necessarily disclose or suggest a brush portion free end not aligned with a longitudinal axis of an end portion of a stem, as recited in the independent claims.

In addition, the Office Action does not provide a proper motivation for combining Gueret and Ashtary. The Office Action alleges that a skilled artisan would have modified Gueret in view of Ashtary “for the purpose of enhancing the ability of the device to curl the eyelashes.” Office Action, page 4, lines 7-10. This allegation appears to be based on a passage in Ashtary including that language. However, the full sentence actually reads: “Also, the brushlike elements can be slightly arched concavely along its longitudinal axis [sic] to further enhance the device’s ability to curl the eyelash (see FIG. 2).” Col. 3, lines 61-64. As is evident from this passage, Ashtary discloses that slightly arching the brushlike elements enhances the ability to curl eyelashes. Ashtary does not disclose or suggest, however, that non-alignment of the brushlike element free end enhances the ability to curl eyelashes, as asserted by the Examiner. In fact, as discussed above, the disclosure of Ashtary is silent with regard to the positioning of the free end. Since neither Ashtary nor Gueret provides any motivation or suggestion to modify Gueret to include a non-alignment feature, nothing provides any motivation or suggestion for the

modification proposed in the Office Action. Consequently, the conclusions in the Office Action were not reached based on facts gleaned from the cited references, but rather from improper hindsight in view of the present application.

Applicant submits that the alleged combination of Gueret and Ashtary does not show a reasonable expectation of success because, among other reasons, the device of Ashtary functions in a significantly different manner than the device of Gueret. The device of Ashtary includes two brushlike elements that are brought into contact with one another by a scissors mechanism. Abstract. Ashtary discloses that “the brushlike elements are . . . capable of applying mascara and curling the eyelash [sic] **when the elements are brought together** via the scissors mechanism.” Col. 3, lines 30-34 (Emphasis added). Nowhere, however, does Ashtary disclose or suggest that the brushlike elements are capable of applying mascara and curling the eyelashes when the elements are NOT brought together. Therefore, there is nothing that would give one of ordinary skill a reasonable expectation that the brushlike elements of Ashtary would be successful at “applying mascara and curling the eyelash[es],” when incorporated into the device of Gueret, which does not require a mechanism for bringing brushlike elements together.

For at least these reasons, Applicant submits that the Office Action has failed to carry the initial burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Thus, the rejection of claims 1, 43, 64, 80, and 96 under 35 U.S.C. § 103(a) based on Gueret and Ashtary should be withdrawn.

With regard to claims 14-16 and 55, the Examiner alleged that it would have been “an obvious matter of design” choice to alter shapes. Office Action, page 5, lines 11-12. However, the Office Action provided no legally proper motivation to alter the shapes of the devices of Gueret or Ashtary. For at least this reason, the Office Action has failed to carry the initial burden

of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Thus, the rejection of claims 14-16 and 55 under 35 U.S.C. § 103(a) based on Gueret and Ashtary should be withdrawn for this additional reason.

III. Conclusion

For at least the reasons set forth above, independent claims 1, 43, 64, 80, and 96 should be allowable. Rejected dependent claims 2-12, 14-16, 20-27, 33-42, 44-51, 55, 61, 62, 65-72, 75-79, 81-88, 91-95, 97-104, and 107-111, as well as withdrawn dependent claims 13, 17-19, 28-32, 52-54, 56-60, 63, 73, 74, 89, 90, 105, and 106 each depend from one of independent claims 1, 43, 64, 80, and 96. Consequently, those dependent claims should be allowable for at least the same reasons as the claims from which they depend.

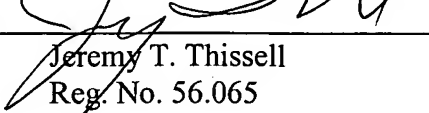
Applicant respectfully requests the reconsideration of this application, the withdrawal of the outstanding claim rejections, and the allowance of claims 1-111.

Please grant any extensions of time required to enter this request and charge any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 28, 2006

By: 
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Reg. No. 56.065